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PATENT

Customer No. 34,986

Attorney Docket No. 01222.0034-00-000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: )  
David A. RUSSO et al. ) Group Art Unit: 1755  
Application No.: 08/544,212 ) Examiner: D. Brunsman  
Filed: October 17, 1995 )  
For: COATING COMPOSITION FOR )  
GLASS )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22315-1450

Sir:

**APPELLANTS' REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193 (b)**

Appellants submit the following reply brief in triplicate pursuant to 37 C.F.R. § 1.193 (b) to respond to the Examiner's Answer of July 2, 2003.

**THE PROSECUTION OF THE REISSUE PATENT**

The appellant's brief on appeal refers to the Russo et al. patent, U. S. 5,401,305 as the reissue patent and this reply brief will identify it in that way as well. Appellants filed the present application to add reissue claims to the Russo et al. patent as permitted by 35 U.S.C. § 251. The Examiner has rejected these claims on the grounds that appellants have attempted to "recapture" subject matter given up in the reissue

patent in order to obtain its allowance. The prosecution history of the reissue patent, summarized as follows, clearly and unequivocally supports their position that the present claims do not include or "recapture" any subject matter given up in the reissue patent in order to obtain its allowance.

Claim 1 of the reissue patent, prior to amendment, claimed a composition, gaseous at temperatures below about 200° C. and atmospheric pressure, that included a tin oxide precursor, a silicon oxide precursor and accelerants selected from organic phosphites, organic borates, and water and mixtures thereof, and a source of oxygen. The presence of the accelerants increased the rate of deposition (reissue patent, col. 4, lines 31-33). The claim also provided that the composition deposit the tin oxide and silicon oxide as a first layer onto glass at rates greater than about 350 Å/sec.

The examiner, in the first office action dated September 20, 1994, rejected all of the claims under 35 U.S.C. § 112 first paragraph, but indicated he would allow claim 1 inter alia if appellants would amend the claim to include all of the limitations of original claim 11 which defined the silicon oxide precursor as a compound having the formula  $R_mO_nSi_p$ .<sup>1</sup> The examiner did not reject the claims on prior art under 35 U.S.C. § 102 or 35 U.S.C. § 103 or any other grounds. Importantly, the examiner did not reject the tin oxide precursor of claim 1 as originally filed nor the organic phosphites and organic borates claimed as accelerants. In fact, appellants when responding to the Office Action on October 25, 1994 in addition to amending claim 1 to include the  $R_mO_nSi_p$

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1. Claim 1, as amended defined  $m$  as 3 to 8,  $n$  as 1 to 4, and  $R$  as independently chosen from hydrogen and acyl, straight, cyclic, for branched-chain alkyl and substituted alkyl or alkenyl, of from one to about six carbon atoms, and phenyl or substituted phenyl.

definition of the silicon oxide precursor set out in claim 11, also amended other claims to redefine the tin oxide precursors and the organic phosphite and organic borate accelerants, even though not called for by the examiner.

Specifically, they amended claim 6 by deleting the definition of the accelerant as triethyl phosphite, and substituting for it organic phosphites and borates having the formulas  $(R''O)_3P$  and  $(R''O)_3B$ ,<sup>2</sup> and adding claim 27 to define inter alia the tin oxide precursor as a compound of the formula  $R_nSnX_{4-n}$ .<sup>3</sup> The examiner neither called for these amendments nor did he reject the claims that now included them, but instead issued a notice of allowance in his next office action of November 14, 1994.

In the reissue patent, the original claims as well as the amended claims only claimed the composition. It never claimed the invention as a film, article of manufacture or product-by-process as now,<sup>4</sup> which the disclosure always supported by noting the "invention. . . [relates to] producing an improved coating on glass, wherein the coated glass exhibits specific properties such as, e.g., controlled refractive index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence on flat glass substrates." (reissue patent col. 4, lines 13-18).

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2.  $R''$  is independently chosen from straight, cyclic, or branched-chain alkyl or alkenyl or from one of  $EtO_2C-$ ,  $CH_3CO-$ , or  $HOOC-$ .

3.  $R$  is a straight, cyclic or branched-chain alkyl or alkenyl of from one to about six carbon atoms ; phenyl, substituted phenyl,  $R'CH_2$ , where  $R'$  is  $MeO_2C-$ ,  $EtO_2C-$ ,  $CH_3CO-$ ,  $HO_2C-$ ,  $X$  is selected from the group consisting of halogen, acetate, perfluoroacetate, and their mixtures, and where  $n$  is 0, 1 or 2.

4. The reissue application adds new claims to a film of the oxides (reissue claims 33-38, 50-52, and 56-60), an article of manufacture (reissue claims 39-49), and a product produced by the process of oxidizing the claimed composition (claims 65 and 66).

The present application also includes claims to the composition<sup>5</sup> broadening the tin oxide precursor definition to metal oxide precursors, but retaining the limitation introduced into the composition claims of the reissue patent by again defining the silicon oxide precursor as a compound of the formula  $R_mO_nSi_p$ . This definition is identical to appellants' October 25 1994 amendment in the reissue patent. The present claims also broaden the definition of the accelerants.

### **THE ISSUES ON APPEAL**

The Examiner basically contends that all claims in the reissue application have to include the parameters of composition claim 1 as amended in the reissue patent, i.e., the silicon oxide precursor  $R_mO_nSi_p$ , the accelerants selected from organic phosphites, organic borates, and water, and only tin oxide precursors, and any broadening of these parameters would recapture subject matter appellants gave up during prosecution of the reissue patent.

Appellants contend they have the right to broaden their claims in the reissue application since the examiner only rejected the silicon oxide precursor in the reissue patent, and did not reject or address the accelerants or the tin oxide precursor. Appellants mindful of the recapture doctrine filed reissue claims to the composition that included the silicon oxide precursor  $R_mO_nSi_p$ , but did not confine those claims to the tin oxide precursor, but rather broadened this parameter to include "metal oxides." They also broadened the definition of the accelerants. Bearing in mind that the reissue patent only claimed compositions, appellant filed additional broadening claims in the reissue

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5. Claims 28, 29, 31, and 32.

application to a different class of inventions, viz., a "film," "article of manufacture," and a "product-by-process" that did not limit the scope of coverage to the silicon oxide precursor  $R_mO_nSi_p$ , the tin oxide precursor or the accelerants of the composition claims of the reissue patent. The examiner remained adamant during the prosecution of the reissue application that appellants could not broaden the claims in this way.

### **THE REISSUE STATUTE AND APPLICABLE CASE LAW**

The reissue statute<sup>6</sup> gives a patentee the right to reissue a defective patent which "is, through error, without any deceptive intention, deemed wholly or partly inoperative or invalid. . . by reason of the patentee claiming. . . less than he had a right to claim in the patent. . . " and to "enlarge the scope of the claims of the original patent. . . [if] applied for within two years from the grant of the original patent." (Emphasis added). In the present application, there is no issue of error without deceptive intent<sup>7</sup> or whether the present application was filed within the two year period to enlarge the scope of the original patent. The appellants claim they have a right to enlarge the scope of the original patent, whereas the examiner takes the position they

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6. 35 U.S.C. § 251

7. "[T]he CCPA [Court of Customs and Patent Appeals] stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Thus the CCPA has construed the term error under section 251 broadly." Ball Corporation v. United States, 729 F. 2d 1429, 221 USPQ 289, 294 (citations omitted). Here, the examiner has neither asserted, nor provided evidence that the appellant omitted or abandoned the subject matter of the present claims.

do not on the grounds that the appellants have tried to recapture subject matter they gave up in order to gain allowance of the patent.

The Court of Appeals for the Federal Circuit and its predecessor court, the Court of Customs and Patent Appeals have developed case law to interpret the reissue concept in order to resolve issues the statute does not address directly. In doing so they found, "[t]he statute [35 U.S.C.] 251] is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). See also, Ex parte Daniel M. Eggert and Frank Mikic (deceased) (Precedential Opinion)(Appeal No. 2001-0790), (Bd. of Pat. App. And Intf., Decided May 29, 2003) Slip Opinion, pp. 18-19. "Error under the reissue statute [,however,] does not include a deliberate decision to surrender specific subject matter in order to overcome prior art. . . ." Mentor v. Coloplast Inc., 998 F. 2d 992, 996, 27 USPQ 2d 1521, 1525 (Fed.Cir. 1993). This is known as "[t]he recapture rule. . . [which] prevents a patentee from regaining through reissue the subject matter which he surrendered in an effort to obtain allowance of the original claims." In re Clement, 131 F. 3d 1464, 45 USPQ 2d 1161, 1163 (Fed. Cir. 1997). "The recapture rule. . . is based on equitable principles." Ball, 221 USPQ at 296. Bearing in mind that "[r]eissue is remedial in nature and is based on fundamental principles of equity and fairness. . . [t]he recapture rule is inherently founded on similar considerations of equity, providing guidance in the application of the law governing reissue." Ball, 221 USPQ at 296. See also, Eggert, pp.18-19. Lastly, even though an inventor does not amend his application during prosecution, his arguments can prevent him from claiming subject matter in a reissue application that he disavowed during prosecution., i. e., "a surrender

can occur through arguments alone." Hester Indus. Inc. v. Stein Inc., 142 F. 2d 1472, 1482, 46 USPQ 2d 1641, 1649 (Fed. Cir. 1998). See also, Eggert, pp. 27-28. Cf., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 122 S. Ct. 1831, 1837, 62 USPQ 2d 1705 (2002) (amendments or arguments to advance prosecution can prevent the application of the doctrine of equivalents in an infringement action).

Stated otherwise, if an applicant amends his application to obtain a patent by adding or giving up a claim element for an invention, or if she or he argues patentability on the grounds that a claim for an invention either contains or does not contain an element, and the examiner allows the claim based on the amendment or argument, he or she cannot obtain that element or eliminate it in a reissue application, contrary to the position previously taken during prosecution. Once having taken the position to obtain allowance of the claim for the invention, the applicant cannot later go back on it.

With this in mind, appellants will show that during the prosecution of the reissue patent, they neither submitted amendments or arguments concerning the metal oxide precursors, accelerants, article of manufacture, film, or product-by-process they now claim, nor did the examiner give them an opportunity to do so since he never addressed any of these issues during the prosecution of the reissue patent. Stated otherwise, appellants do not recapture subject matter with the present claims that they gave up by way of amendment or argument in the prosecution of the reissue patent.

#### **THE EXAMINER'S ANSWER**

Appellants will address the issues raised in the order they appear in the Examiner's Answer. Page five of the Examiner's Answer, initially attempts to argue the

so-called Clement analysis<sup>8</sup> applies to all the reissue claims, however ignores that Clement only bears on instances where an applicant distinguished prior art cited either under 35 U.S.C. §§ 102 or 103, and not rejections under 35 U.S.C. §112, the only rejection the examiner made in the reissue patent. If the Clement analysis has any bearing at all the examiner would have to apply it to the only composition claims in the reissue application, claims 28, 29, 31, and 32, since the reissue patent only contained composition claims. Reissue claims 28, 29, 31, and 32 claim the composition differently in that these claims, as noted before do not limit coverage to tin oxide precursors, but rather metal oxide precursors, and importantly include the composition limitation introduced into the reissue patent by the October 25, 1994 amendment that requires a compound of the formula  $R_mO_nSi_p$  as the silicon oxide precursor. Claim 32 also broadens the accelerants. The examiner never rejected the tin oxide precursor of the reissue patent or the accelerants, and appellants never amended the reissue claims or made arguments regarding the patentability of the tin oxide precursors or the accelerants either with regard to 35 U.S.C. § 112, or any prior art. Furthermore, appellants never indicated in any way in the written description of the reissue patent or its prosecution that the metal oxide precursors or accelerants now claimed did not comprise part of the invention, and the examiner does not now argue or point to anything that show appellants did this.

The tin oxide precursor and the accelerants amount to aspects unrelated to the rejection, and according to Clement, with reissue claims 28, 29, 31, and 32 to the composition narrower in an aspect germane to the rejection (i.e., these claims continue

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8. In re Clement, 131 F.2d 1464, 45 USPQ 2d 1161 (Fed. Cir. 1997)



to carry the amended silicon oxide precursor as  $R_mO_nSi_p$  ) and broader in an aspect unrelated to the rejection (i.e., the metal oxide precursors and accelerants), the recapture rule does not bar claims 28, 29, 31, and 32. Clement, 45 USPQ 2d at 1165.

Clement, however, does not apply to the film claims, article of manufacture claims or product-by-process claims 33-60 and 65, 66, since appellants never presented these claims for prosecution in the reissue application, and never indicated in any way in the written description of the reissue patent that they did not constitute part of the invention. As appellants argued in their Brief in Chief, the amendments in the reissue patent directed toward composition claims do not carry over to film claims, article of manufacture claims or product-by-process claims in the present reissue application since they comprise different statutory classes of inventions. Different statutory classes of invention are separate inventions. Studiengesellschaft Kohle mbH v. Northern Petrochemical Company, 784 F.2d 351, 228 U.S.P.Q. 837, 839 (Fed. Cir. 1986). They differ in that infringement of one type of claim doesn't carry any presumption of infringement of the other. Prosecution of the reissue patent composition claims therefore has no bearing on the film claims, or article of manufacture claims, or product-by-process claims in the present application.

Page five of the Examiner's Answer cites Eggert to support the examiner's contention that the "patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered." The examiner has not pointed to anything in the prosecution of the reissue patent that shows appellants conceded the unpatentability of the presently claimed metal oxide precursors,

accelerants, film, article of manufacture or product-by-process, or that they abandoned or surrendered this part of the invention.

Also on page five of the Examiner's Answer he argues that "[t]he decision not to appeal is an irrevocable admission of unpatentability" (citing Festo), and "[t]he recapture rule prevents a patentee from regaining rejected subject matter." (citations omitted). Appellants only reply that the examiner never had claims to the present accelerants, metal oxide precursors, film, article of manufacture or the product-by-process before him in the reissue patent, and therefore did not reject them. The examiner also did not reject the tin oxide precursors or the accelerants in the reissue patent. Appellants therefore could not appeal issues that pertained to these unclaimed and unrejected aspects of the invention, and the examiner cannot now imply that at one time he rejected claims to these aspects of the invention.

Page five of the Examiner's Answer also argues that "[r]eissue does not give the patentee the right to prosecute de novo his original application." citing In re Weiler, 790 F. 2d 1576, 229 USPQ 673 (Fed. Cir. 1986). Appellants' reissue application does not prosecute original claims 1-28 of the reissue patent again by amending them, but only presents additional reissue claims that enlarge the scope of the original patent. The reissue statute, 35 U.S.C. § 251, sanctions this.

The examiner goes on to argue that reissue claims 33-57 do not recite the  $R_mO_nSi_p$  parameter of original claim 11 and expand the tin oxide precursor of the reissue patent to "metal oxide precursors." (Examiner's answer, p. 7, 2nd full par.). He continues, "[u]nder part (1) of the analysis of Clement, these claims are as broad as or

broader than the cancelled subject matter in all aspects and they are barred by the recapture rule." (Examiner's answer, p. 7, 2nd full par.). To the extent that the examiner implies that appellants canceled subject matter pertaining to the tin oxide precursors or accelerants in the reissue claims, an examination of the prosecution of those claims shows that appellants never cancelled the tin oxide precursors or argued the scope of the tin oxide precursors or the accelerants in response to a rejection in order to advance the prosecution of these claims. The examiner cannot now say that appellants treatment of the tin oxide precursors in the prosecution of the reissue patent now bars them from claiming the metal oxide precursors, since all that appellant did in the earlier prosecution was to leave the original terms "tin oxide precursor" and " $R_nSnX_{4-n}$ " intact in the reissue claims which the examiner never rejected nor objected to. Interestingly, he subsequently allowed the claims with both of these descriptions.

Similarly, appellants retained the original definition of the accelerants in claims 1-5, but amended claim 6 to change the triethyl phosphite accelerant to organic phosphites and borates having the formulas  $(R''O)_3P$  and  $(R''O)_3B$  even though the examiner never rejected the accelerants or raised an objection to them. Interestingly, he subsequently allowed the claims with both of these descriptions. As with the tin oxide precursors, to the extent that the examiner implies that appellants canceled subject matter pertaining to the accelerants in the reissue claims, an examination of the prosecution of those claims shows that appellants never cancelled the broad description of the accelerants or argued the scope of the accelerants in response to a rejection or objection in order to advance the prosecution of these claims. The examiner cannot

say that appellants' treatment of the accelerants in the reissue prosecution now bars them from claiming them in the manner set out in the reissue claims.

The paragraph bridging pages seven and eight of the Examiner's Answer describes film claims 58 and 59 as broader than composition claim 1 in that these film claims cover oxides of tin, silicon and phosphorous without identifying the  $R_mO_nSi_p$  silicon oxide precursor of composition claim 1. Appellants have not attempted recapture with these claims since they never presented film claims in the reissue prosecution, which is to say they never amended any film claims to include the  $R_mO_nSi_p$  silicon oxide precursor. As noted previously, film claims comprise a different category of invention than composition claims, and the prosecution of the composition claims has no bearing on the recapture issue in subsequently presented film claims.

The examiner views the written description of the application as evidencing a "specific intent not to claim subject matter not exhibiting the deposition rate. . . ." (i. e., the deposition rate of greater than about 350 Å/sec. obtained when using the silicon oxide precursor of the formula  $R_mO_nSi_p$ )(Examiner's Answer p. 9). The examiner then cites MPEP §1412.01 (B) which has no bearing on the present case, since it only pertains to instances where the applicants specifically state their invention does not pertain to a specific embodiment, and they subsequently attempt to claim that embodiment. Here, the examiner has not pointed to anything in the application where the appellants have stated or implied their invention does not pertain to the presently claimed composition, film, article of manufacture or product-by-process. Granted, one aspect of the invention does focus on the deposition rate of greater than about 350 Å/sec. obtained when using the silicon oxide precursor of the formula  $R_mO_nSi_p$ , but the

invention, as pointed out before in this Reply Brief, does not stop there. The "invention. . . [also relates to] producing an improved coating on glass, wherein the coated glass exhibits specific properties such as, e.g., controlled refractive index, abrasion resistance, color enhancement, low emissivity, selective light filtration, and anti-iridescence on flat glass substrates." (reissue patent col. 4, lines 13-18). These inventions are in addition to those of the composition claims that focus on obtaining improved coating speeds with the silicon oxide precursor of the formula  $R_mO_nSi_p$ . Appellants refer The Board to their position on this point in the Brief in Chief at pp. 17 and 18 for a further discussion.

The examiner dismisses appellants' citation of In re Wesseler, 367 F. 2d 838, 847, 151 USPQ 339 (CCPA 1966) arguing that the court did not find recapture because they could not "distinguish whether the amendments made to secure patentability were due to the rejection under §112 (2) or the prior art such that the court could not determine which material had been actually surrendered." (Examiner's Answer, p. 10, first full par.) (emphasis added). The court, contrary to the examiner's assertion, however, did make the determination that where the application was previously rejected under both 35 U.S.C. § 112 and 35 U.S.C. § 103, (Wesseler, 151 USPQ at 345) the case as it stood before them for decision was no longer rejected on prior art, noting "[h]ere, however, there is no objection to the appealed [reissue] claims based on prior art. We do not think the Statement in Shepard [ Shepard v. Carrigan, 116 U.S. 593, 5976 S. Ct. 493, 495, 29 L. Ed. 723 (1886)]. . . is applicable here. Sheppard may be support for the rule that one who deliberately adds a limitation to avoid the prior art

cannot omit that limitation in reissue claims. . . but that is not the situation here.”  
(Wesseler, 151 USPQ at 345-46).

As to the examiner’s contention that the “court could not determine which material had been actually surrendered” appellants point out that the court found the reissue claims omitted a limitation introduced in the prosecution of the parent application, i.e., an “offset ear” (Wesseler, 151 USPQ at 344, 1<sup>st</sup> full par.; 151 USPQ at 345, 2nd full par.), but nonetheless held that broadening the claims by this omission did not bar them under the recapture doctrine. (Wesseler, 151 USPQ at 346, 349).

The examiner in attempting to distinguish Wesseler, argues that appellants relied on that decision for the definition of “error” in the reissue statute, however, appellants did not. The examiner cites In re Wadlinger, Kerr and Rosinski, 181 USPQ 826 (CCPA 1974) to support his position, but even though Wadlinger addresses the use of the term “error” in the statute, it does not overrule or “eviscerate” (examiner’s Answer p. 10) the underlying principle in Wesseler that allowed broadened claims in a reissue application where the application only stood rejected on grounds of insufficiency of disclosure, and not prior art. The case on appeal, as in Wesseler, also addresses the issue of alleged recapture where the examiner only rejected the claims under 35 U.S.C. §112, and not prior art. Interestingly, the applicants in Wesseler, as in the present application, copied claims from an issued patent in order to provoke an interference. Wesseler 151 USPQ at 342.

The claims do not stand or fall together for the reasons appellants have given in their Brief in Chief at pp. 18-19, contrary to the arguments the examiner attempts to use on page 11, first full paragraph, of the Examiner’s Answer. Appellants cannot fully

respond to the reasons the examiner offers in support of his position because the last sentence on page 11, first full paragraph, of the Examiner's Answer is not complete.

### **CASE LAW SUPPORTS THE APPELLANTS' BROADENED REISSUE**

Wessler allows the appellants to file broadened reissue claims where the examiner has rejected the application under 35 U.S.C. §112 as discussed above. The reissue claims covering the composition, claims 28, 29, 31, and 32 retain the definition of the silicon oxide precursor,  $R_mO_nSi_p$ , introduced during the prosecution of the reissue patent, but broadened the tin oxide precursor to "metal oxide precursors" and broadened the accelerants. The examiner never objected to or rejected the tin oxide precursors or accelerants in the reissue patent, and appellants never amended these terms in response to a rejection. Appellants never presented the presently claimed metal oxide precursors and accelerants in the reissue application, and accordingly never introduced arguments or amendments to advance their prosecution in that application.

Case law makes clear that the recapture doctrine applies only to amendments or arguments that address patentability issues advanced during the course of prosecution of an application in order to overcome a rejection. The presently claimed metal oxide precursors, accelerants, film, article of manufacture or product-by-process also were not rejected, nor could they, since appellants did not present those claims in the reissue patent. Where an appellant has not urged patentability in either way, i.e., by amendment or argument, recapture does not exist. Ball Corp. v. United States, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984); In re Wallingham, 282 F.2d, 353, 127

U.S.P.Q. 211-215 (C.C.P.A. 1960); In re Wadlinger et al., 496 F.2d 1200, 181 U.S.P.Q. 826, 830, 832 (C.C.P.A. 1974). Also, "where claims have not been previously cancelled, relative claim scope is not available to illuminate the alleged error" Ball, 729 F.2d at 1434, 221 U.S.P.Q. at 295, and fn. 19 (Emphasis added).

The film, article of manufacture or product-by-process claims on appeal differ from the composition claims of the reissue patent, as different classes of invention as held in Studiengesellschaft Kohle mbH. As the court stated in Wadlinger, "[a]s for obtaining claims on reissue that are different<sup>9</sup>, no prohibition arises merely because of the language of the reissue statute. Still apropos and basic is our statement in Wessler, 151 USPQ at 348: '[w]e think the term 'error,' . . . is to be interpreted in light of the Supreme Court decisions favoring the liberal construction of reissue statutes in order to secure to inventors protection for what they actually invented.'" Wadlinger, 181 USPQ at 832 (Emphasis added).

The Court of Appeals for the Federal Circuit in In re Doyle, 293 F. 3d, 1355, 63 U.S.P.Q. 2d 1161 (Fed. Cir. 2002) held that failure to prosecute restricted species or subgeneric claims in a divisional application did not prevent the inventor from reissuing the base patent to claim the invention as a genus that dominated the abandoned restricted species or subgeneric claims. The applicant had not presented those generic claims in the underlying patent, and the Board of Patent Appeals and Interferences correctly ruled that the recapture doctrine did not apply, rejecting the claims in stead on

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9. In Wadlinger, the appellants claimed a zeolite and the method of making it in the original patent. On reissue they claimed a different invention, viz. a method for using zeolite beta as a catalyst for the cracking of hydrocarbons. Wadlinger, 181 USPQ at 827.



the Orita doctrine.<sup>10</sup> This case, as in Wadlinger, also stands for the proposition that an applicant can claim different inventions in reissue than those of the original patent.

#### **OFFER IN THE ALTERNATIVE TO DEDICATE CLAIMS TO THE PUBLIC**

If, despite the above arguments, the Board maintains that claims 33-60, 65-66 can be rejected on the grounds that appellants have attempted to recapture subject matter that should have entered into the public domain by being previously abandoned in the prosecution of the reissue patent, then again appellants, in the alternative traverse the "recapture" rejection by offering to dedicate back to the public, reissue claims 33-60, 65-66 on the terms and conditions set out on pp. 19-21 in their Brief in Chief.

#### **Conclusions**

Appellants request the Board to overrule the Examiner in all respects, and remand the application to the Examiner for issuance of a Notice of Allowance. If the Board overrules the Examiner appellants request that the Board indicate if they base their action upon appellants' arguments, or upon appellants' alternative offer to dedicate claims 33-60, 65-66 to the public as set out at pp. 18-21 in their Brief in Chief.

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10. In re Orita, 550 F.2d 1280, 193 USPQ 145 (CCPA 1977) holding that an applicant could not prosecute restricted claims in a reissue application where the applicant never filed a separate application for those claims after the restriction requirement.



Respectfully submitted,

The Law Offices of Robert J. Eichelburg

By: Robert J. Eichelburg  
Robert J. Eichelburg, Reg. No 23,057

Dated: August 29, 2003

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

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By: Robert J. Eichelburg  
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Dated: August 29, 2003